

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/598,373  
Filing Date: December 27, 2006  
Applicant(s): SWALLOW et al.  
Title: ELECTRICAL COMPONENTS AND CIRCUITS CONSTRUCTED AS TEXTILES

Group Art Unit: 1794  
Examiner: Choi, Peter Y.  
Atty. Docket: 78104114

REQUEST FOR RECONSIDERATION OF  
REQUIREMENT FOR ELECTION  
(37 CFR §1.143)

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In Response to the Office Action of November 18, 2009, reconsideration of the election requirement is requested in light of the following comments.

**1. Summary of Election Requirement**

The Office Action contends that the application contains claims directed to patentably distinct species of the invention, i.e., species I (serpentine path) and species II (spiral path). The Office Action requires identification of an elected species and a listing of all claims readable thereon so that restriction to the elected species can be made if no generic claim is finally held to be allowable.

I certify that this paper is being electronically submitted to the U.S. Patent and Trademark Office via the EFS-Web online filing system on the following date:

14 DEC 2009

Date of Electronic Submission

Signature

**2. Provisional Election of Group (37 CFR §1.143)**

The spiral path of Group II (claims 1, 8, 9, 15, 17-20, 28, 30-35, and 37) is provisionally elected for further examination, subject to the traverse below.

**3. Traverse**

The Office Action alleges that election is appropriate because:

The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

However, these statements are conclusory and unsupported, and plainly incorrect. Initially, as for the allegations that the species require a different field of search or different prior art applies to the species, note that these are essentially the same allegation: what constitutes a "different field of search" is defined in MPEP 808.02 and MPEP 904-904.03, and MPEP 808.02 states that a different field of search exists "where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s)." MPEP 904-904.03 then provide guidelines for the field of the search to be performed prior to examination of an application. It is noted that the art must be searched with respect to variant embodiments (MPEP 904.01(a)), patentable equivalents (MPEP 904.01(b)), and analogous art (MPEP 904.01(c)). MPEP 904.02 further notes that the Examiner's field of search should "cover the claimed subject matter and should also cover the disclosed features which might reasonably be expected to be claimed" (as does MPEP 904.02(a)), and MPEP 904.03 states that the search must be "commensurate with the limitations appearing in the most detailed claims in the case." *If a proper search is performed in accordance with these provisions – e.g., to search for analogous art as required by MPEP 904.01(c) – how can one of the species be searched without inherently searching for the other?* The species have the same characteristics save for the shape of their paths, and in order to search for relevant art, the scope of a search for the invention with a spiral path will necessarily require a review of art dealing with paths of other shapes, including serpentine shapes.

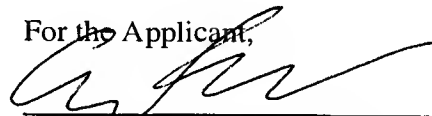
As for the allegation that the species are “likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph,” this is plainly untrue from even a brief review of the claims. *What issues would these be?*

With all respect, there is no reasoned basis for the election requirement; rather, there is merely a conclusory Office form paragraph alleging that an election is appropriate. The species clearly require the same field of search, and have the same relevant prior art, and are subject to the same §101 and §112 analyses. Kindly withdraw the election requirement and examine all claims. Alternatively, if the election is maintained, kindly provide support for the election requirement so that the Applicant can determine whether a Petition is appropriate.

**4. In Closing**

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

For the Applicant,



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